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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,428	12/27/2001	Koichi Sawada	016891-0842	1549

22428 7590 06/29/2005

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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,428	SAWADA, KOICHI	
	Examiner	Art Unit	
	Evens Augustin	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 27 December 2001.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-15 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date <u>12/27/2001</u> .	6) <input type="checkbox"/> Other: _____

Status of Claims

1. Claims 1-15 have been examined.

Claim Rejections - 35 USC § 112

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim recites, "acquiring the test..." which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Rudy et al. (U.S. 6,360,252).

As per claims 1-15, Rudy et al. discloses an invention comprising of:

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- A system and method for receiving (column 13, lines 18-67, column 14, lines 1-38) and sending electronic mail (column 14, lines 40-67, column 15, lines 1-54) and means for sending and receiving electronic mail (figures 3-7). A destination field/text is included when sending electronic mail (column 14, lines 65-67, column 15, lines 1-4) and the received electronic message includes a field/text that shows the originating source of the message (column 14, line 36) – *Claims 1-4*
- System and method for billing the originating user's account after forwarding an electronic email item (column 23, lines 16-20) – *Claims 4, 8*
- A system for receiving (column 13, lines 18-67, column 14, lines 1-38) and sending electronic mail (column 14, lines 40-67, column 15, lines 1-54) and means for sending and receiving electronic mail (figures 3-7). A destination field/text is included when sending electronic mail (column 14, lines 65-67, column 15, lines 1-4) and the received electronic message includes a field/text that shows the originating source of the message (column 14, line 36). The user sends/transmits the electronic message from his/her server to the recipient's server (column 15, lines 28-43) – *Claims 5, 6, 7*
- Instruction data in a computer readable storing medium (column 8, lines 35-40, column 9, lines 1-4 and lines 11-27) and electrical signals that carry data streams (column 28, lines 44-48 and lines 57-63) for:
 - a. Receiving electronic messages (column 13, lines 63-67) – *Claims 9-12 and 14-15*
 - b. Identifying originating source (column 14, line 36) – *Claims 9-12 and 14-15*

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- c. Identifying message destination (column 14, lines 65-67, column 15, lines 1-36) – *Claims 9-12 and 14-15*
- d. Acquiring the text/body of message (column 15, lines 20-27) – *Claims 9-12 and 14-15*
- e. Appending the text to the recipient's message page and transmitting the text/message to recipient's client computer (figure 6, item 314, figure 11, item 530) – *Claims 9-12 and 14-15*
- f. Billing the originating user's account once the message has been transmitted and confirmed (column 24, lines 16-18) – *Claims 9- 12 and 14-15*
- Java Programming language is used to accomplish the above processes (column 26, line 25). One of the basics behind java programming is that it is a computer program composed of a collection of individual units, each capable of receiving/processing and sending data – *Claim 13*

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Christenson et al. (US 20020112008)
- Delany e al. (US 6658454)
- RAMACHANDRAN et al. (US 20030140112)

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
May 9, 2005
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JAMES P. TRAMMEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

